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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,039	08/27/2003	James J. Kernz	16514	5136
43935	7590	05/09/2006	EXAMINER	
FRASER MARTIN & MILLER LLC 28366 KENSINGTON LANE PERRYSBURG, OH 43551			LEVINE, ADAM L	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,039	KERNZ, JAMES J.	
	Examiner	Art Unit	
	Adam Levine	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a method for grading, encapsulating, and commoditizing objects, classified in class 705, subclass 27.
- II. Claims 17-32, drawn to methods for facilitating the exchange of trade ready graded encapsulated objects utilizing a network, comprising providing a marketplace computer, receiving trade data, providing searching to buyers, and receiving data from sellers, classified in class 705, subclass 27.
- III. Claims 33-41, drawn to a method for providing a database of information regarding exchanges of objects, comprising selecting objects based on criteria, storing data including price realized, providing access to data by selecting criteria, and connecting the database to a host and a remote computer to a host for transferring data, classified in class 705, subclass 27.
- IV. Claims 42-51, drawn to a method for providing a database including bias correction, comprising gathering data regarding transactions, including searching data, scanning data, or obtaining a pool of data from a provider, storing data, correcting bias in data, and storing bias corrected data

gathered from selected transactions among a plurality of transactions, classified in class 705, subclass 27.

- V. Claims 52-58, drawn to an integrated market exchange system, comprising a marketplace computer controlled by a trade facility storing buy and sell offers for coins selected from a plurality provided by a third party grading firm, a host controlled by a market maker, a communication means connecting the marketplace, host, buyers and sellers, wherein the marketplace provides access to the host, classified in class 705, subclass 26.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as grading, encapsulating, and commoditizing the object. See MPEP § 806.05(d).
2. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as grading, encapsulating, and commoditizing the object. See MPEP § 806.05(d).
3. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in

scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as grading, encapsulating, and commoditizing the object. See MPEP § 806.05(d).

4. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as grading, encapsulating, and commoditizing the object. See MPEP § 806.05(d).

5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as providing a marketplace computer. See MPEP § 806.05(d).

6. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as providing a marketplace computer. See MPEP § 806.05(d).

7. Inventions II and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

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806.05(e)). In this case the method of invention II can be practiced by a materially different apparatus or by hand, and the system of invention V can be used to practice another materially different process as shown by the control of the marketplace computer by a trade facility not present in invention II, and control of the host by a market maker also not present in invention II.

8. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as correcting bias in data, using a statistical model, and storing bias corrected gathered selected data from a plurality of transactions. See MPEP § 806.05(d).

9. Inventions III and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of invention III can be practiced by a materially different apparatus or by hand, and the system of invention V can be used to practice another materially different process as shown by the control of the marketplace computer by a trade facility not present in invention III, and control of the host by a market maker also not present in invention III.

10. Inventions IV and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be

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practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of invention IV can be practiced by a materially different apparatus or by hand, and the system of invention V can be used to practice another materially different process as shown by the control of the marketplace computer by a trade facility not present in invention IV, and control of the host by a market maker also not present in invention IV.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. This application contains claims directed to the following patentably distinct species:

I.A. Invention I contains claims 9, 10, and 11, directed to different species of unique identifying criteria. The species are independent or distinct because in claim 9 the unique identifying indicia is an assigned unique certificate number, in claim 10 the unique identifying indicia is an assigned unique URL, and in claim 11 the unique identifying indicia is an assigned unique machine readable bar code.

In the event Applicant elects Invention I, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to

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which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 4 is generic.

III.A. Invention III contains claims 34,35, and 36, directed to different species of unique identifying criteria. The species are independent or distinct because in claim 34 the unique identifying indicia is an assigned unique certificate number, in claim 35 the unique identifying indicia is an assigned unique URL, and in claim 36 the unique identifying indicia is an assigned unique machine readable bar code.

In the event Applicant elects Invention III, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 33 is generic.

III.B. Invention III also contains claims 40 and 41, directed to different species of peer-to-peer transactions. The species are independent or distinct because in claim 40 the transaction is an auction, while in claim 41 the transaction is a fixed price transaction.

In the event Applicant elects Invention III, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 39 is generic.

IV.A. Invention IV contains claims 44 and 45, directed to different species of searching facilities for data. The species are independent or distinct

because in claim 44 the searching is performed manually, while in claim 45 the searching is performed using a persistent operative scanning agent.

In the event Applicant elects Invention IV, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 43 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Given the complexity of this Election/Restriction requirement, a telephonic election was not attempted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh C. Garg can be reached on 571.272.6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine
Patent Examiner
May 4, 2006



Robert M. Pond
Primary Examiner